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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,677	07/24/2000	Guy Nathan	871-85	6899

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EXAMINER	
SALTARELLI, DOMINIC D	
ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/621,677	NATHAN, GUY	
	Examiner	Art Unit	
	Dominic D. Saltarelli	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-6,19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-6,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 16, 2006 has been entered.

Response to Arguments

2. Applicant's arguments filed may 16, 2006 have been fully considered but they are not persuasive.

First, regarding the usage of official notice, applicant argues against the usage of official notice to teach the use of multitask operating systems in audiovisual reproduction systems (applicant remarks, page 5, last paragraph).

In response, the use of official notice to which applicant is referring was not traversed by the applicant after the official notice was taken in the office action mailed September 9, 2004, and was noted as an admission of the fact therein in the office action mailed on November 17, 2005.

Further, the official notice taken that It is notoriously well known in the art to update databases of content made available to users based upon the popularity of said content was not traversed by applicant, and has been taken as an admission of the fact therein. See MPEP 2144.03, which states:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Second, applicant argues that Martin should not form the basis of a rejection of claim 4 because it is not directed to the claimed invention (applicant's remarks, page 6, first paragraph).

In response, the examiner respectfully disagrees with applicant's assertion, because Martin teaches managing computer jukeboxes in the same manner in which applicant's claimed invention manages an audiovisual reproduction system (a jukebox as well), with the only significant difference being the use of a questionnaire usable by customers to request new songs.

Third, applicant argues that Moskowitz' menu-driven process does not comprise a questionnaire as required by claim 4, stating that the questionnaire claimed does not allow a user to select any records (applicant's remarks, page 6, last paragraph).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the questionnaire claimed does not allow a user to select any records) is not recited in the rejected claim. Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Fourth, applicant argues that Moskowitz recites allow subscribers to act as providers as well as consumers of data (applicant's remarks, page 7, lines 3-4).

In response, this particular recitation of Moskowitz is irrelevant to the combination of Martin, Moskowitz and Wilder proposed in the instant office action. It is not the disclosure of Moskowitz alone which must be considered, but what the combination of Martin, Moskowitz, and Wilder teach together as a whole.

Fifth, applicant argues that while Moskowitz requires a series of successive operations performed by a user to select records, the claimed invention avoids repeated movements of the operator to order new selections (applicant's remarks, page 7, lines 5-11).

In response, the examiner must note that providing answers to a questionnaire requires repeated movements of an operator in order to answer each question posed by the questionnaire, and therefore the claimed invention does not avoid repeated movements of the operator to order new selections as asserted by applicant.

Sixth, applicant argues that Moskowitz recites navigating in a series of menus, not providing a questionnaire where answers to said questionnaire are stored and used to request selections (applicant's remarks, page 7, line 12 through page 8 line 8).

In response, the menu driven system of Moskowitz is a questionnaire because it poses a series of questions to a user in the form of choices which, when answered, eventually result in the display of a redacted list of song selections which meet the criteria established from evaluation of said user's selections [answers] (see Moskowitz, col. 4, lines 11-24). Said selections are assembled in memory into a formal request which is then sent to an exchange which returns the song selections identified in the request.

Seventh, applicant argues that one of ordinary skill in the art would not be motivated to combine the teachings of Martin and Moskowitz, claiming the combination is impermissible hindsight because Martin provides a solution to the problem of requesting songs for download (applicant's remarks, page 8, lines 9-18).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the problem being solved is providing an interface for requesting songs for download to the jukebox, but the solution presented by Martin has shortcomings. Namely, the user must know ahead of time which song they wish to download, and enter said song without knowing whether said song is even available for download. The interface taught by Moskowitz remedies these deficiencies.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (5,355,302, of record) [Martin] in view of Moskowitz (5,428,606, of record) and Wilder (5,408,417, of record).

Regarding claim 4, Martin discloses an audiovisual reproduction system (fig. 1, jukebox 13) comprising a central unit (fig. 1, processing circuit 121, col. 5, lines 26-41) controlling a display (fig. 1, visual display 125, col. 5, lines 45-46), memory (fig. 1, ROM 121B, RAM 121C, and storage 93), and a telecommunications modem (fig. 1, modem 19) connected to a distribution

network (fig. 1, distribution network 15) controlled by a host server (fig. 1, central management system 11) through an operating system (software program contained in ROM, col. 5, lines 26-31) comprising a library of tools and services (the operating system controls all features and functions of the jukebox, including the graphical display, money collection, and song selection, and data collection, fig. 5 and col. 6 line 59 – col. 7 line 17).

Martin fails to disclose the operating system is a multitask operating system, the use of a touch screen, and the operating system comprises a listing mechanism for providing a list including information of downloadable audiovisual records that are not yet available on the audiovisual reproduction system, a storage mechanism for storing in the memory a file that organizes information of said list into a questionnaire, and a module including a procedure for reading from the memory the file storing said questionnaire, a procedure for enabling a plurality of data representative of audio visual records to be displayed by the display, said plurality of data being integrated in said questionnaire, a procedure for interpreting answers to said questionnaire and selecting downloadable audiovisual records, said answers corresponding to user actions on the touch screen, a procedure for updating a user's choices file, said user's choices file storing said answers and/or interpretation of said answers, said user's choices file being updated whenever a user provides at least one answer to said questionnaire, and a procedure using said user's choices files for selecting downloadable audiovisual records and automatically sending a request to the

host server requesting that at least one selected audiovisual record be downloaded.

In an analogous art, Moskowitz teaches a menu driven means for selecting music to download to an audiovisual reproduction device, wherein a list of available content for download is provided (col. 3, lines 5-6), the content is organized into a questionnaire (menu driven selection), and displaying the questionnaire to users, wherein the answers to said questionnaire provided by the user are interpreted to select downloadable audiovisual records (col. 4, lines 11-24), and automatically sending a request to a host server requesting that at least one selected record be downloaded (col. 4, lines 25-36), for the benefit of providing an intuitive interface that assists users in finding songs that are both of interest to the user and available for download.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclose by Martin to include a menu driven means for selecting records to download to the audiovisual reproduction device, wherein a list of available content for download is provided, the content is organized into a questionnaire, and displaying the questionnaire to users, wherein the answers to said questionnaire provided by the user are saved to a user's file (the request is a file sent to the exchange, col. 4, lines 25-36, which lists in it a single song, group of songs, or an entire album of songs, col. 4, lines 11-24) and subsequently interpreted to select downloadable audiovisual records, and automatically sending a request (the request being the file which has been

updated with user input to the menu selection) to a host server requesting that at least one selected record be downloaded, as taught by Moskowitz, for the benefit of providing an intuitive interface that assists users in finding songs that are both of interest to the user and available for download.

Martin and Moskowitz fail to disclose the operating system is a multitask operating system and the use of a touch screen.

The official notice taken that it is old and well known to utilize multitask operating systems for controlling dynamic digital systems, as such operating systems are optimized for concurrent execution of multiple tasks, thus enabling systems which are capable of multiple tasks to perform them simultaneously, optimizing the performance and usefulness of the system, was not traversed by the applicant, and is thus taken as an admission of the facts therein.

Therefore, it would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin and Moskowitz to include a multitask operating system, for the benefit of optimizing the performance and usefulness of the audiovisual reproduction system.

In an analogous art, Wilder teaches an audiovisual reproduction system with a touch screen for user selections (col. 4, lines 13-22), providing an intuitive form of user selections from a very flexible interface.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin and Moskowitz to include a touch

screen, as taught by Wilder, for the benefit of providing an intuitive form of user selections of requested songs from a very flexible user interface.

Regarding claim 5, Martin, Moskowitz and Wilder disclose the audiovisual reproduction system of claim 4, wherein the reproduction system downloads a list of audiovisual records on the host server through the information distribution network (Martin, song catalog updates, col. 5, lines 8-25 and col. 6, lines 19-30), the host server then downloading the songs in the list prepared by the operator into the memory means of a determined audiovisual reproduction system through the same network (Martin, song library updates, col. 5, lines 8-25 and col. 6, lines 30-34).

Regarding claim 19, Martin, Moskowitz, and Wilder disclose the system of claim 4, wherein said module of the operating system is adapted for updating a file storing user's answers memorized in the memory (Martin, col. 7, lines 13-17), said module updating a user's answers file whenever a user choose though an action on the touch screen a new audiovisual record in said list (Martin, col. 5 line 60 – col. 6 line 7).

Regarding claim 20, Martin, Moskowitz, and Wilder disclose the system of claim 5, but fail to disclose a counter for counting the number of times that an audiovisual record is chosen in said list, said module comparing this number with

a predetermined threshold so as to perform interpretation of user's answers and enable selection of downloadable audiovisual records.

It is notoriously well known in the art to update databases of content made available to users based upon the popularity of said content. For example, in many video on demand systems, the movies that are made most readily available, such as downloading to a user's home system, or transfer to a high speed memory, is determined by the number of times a movie is requested by users. Said titles have to be requested at least a certain number of times before being considered "popular" enough to warrant transfer.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin, Moskowitz, and Wilder to include a counter for counting the number of times that an audiovisual record is chosen in said list, said module comparing this number with a predetermined threshold so as to perform interpretation of user's answers and enable selection of downloadable audiovisual records, for the benefit of downloading only the most popular records into the limited amount of space available in the local database.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin, Moskowitz, and Wilder as applied to claim 4 above, and further in view of Kalis et al. (6,212,138, of record) [Kalis].

Regarding claim 6, Martin, Moskowitz, and Wilder disclose the system of claim 4, wherein the host server (Martin, fig. 1, central manager 11) sends

commands which program the reproduction system (Martin, fig. 1, jukebox 13) remotely (col. 5, lines 60-63 and col. 6, lines 48-54), but fail to disclose sending orders which are memorized by the reproduction system and used to play particular songs at particular moments.

In an analogous art, Kalis teaches programming a jukebox to play particular songs at particular moments (col. 10, lines 30-64), advantageously providing for a more flexible jukebox.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin, Moskowitz, and Wilder to include programming the reproduction system to play particular songs at particular moments, as taught by Kalis, for the benefit of providing a more flexible audiovisual reproduction system.

Conclusion

6. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
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_____

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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